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I hereby certify that this Response (along with any paper referred to as being attached) is being transmitted via facsimile 703-872-9310 to Mail Stop Non Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date: 9/3/04
Rhea C. NersesianIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Inventor(s): Gelfand et al.

Serial No.: 10/052,417

Filed: 01/17/2002

Title: THERMOSTABLE DNA POLYMERASES
INCORPORATING NUCLEOSIDE
TRIPHOSPHATES LABELED WITH
FLUORESCCEIN FAMILY DYESPATENT APPLICATION

Art Unit: 1634

Examiner: Sitton, Jehanne Souaya

Confirmation No. 4095

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RESPONSE UNDER 37 C.F.R. § 1.111

Mail Stop Non Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants have carefully considered the Office Action mailed June 10, 2004 in connection with the above-identified application and respectfully request consideration of the accompanying remarks and entry of the attached Information Disclosure Statement under 37 C.F.R. §§1.56, 1.97 and 1.98, and a Terminal Disclaimer under 37 C.F.R. § 1.321(c).

Information Disclosure Statement

Applicants thank the Office for consideration of the IDS filed 2/19/03 and acknowledge that the cited Hungarian publications have not yet been considered. These publications were cited for the corresponding Hungarian patent applications (which have meanwhile been abandoned); these references do not contain any subject matter relevant for the present application.

Applicants file herewith a Supplemental IDS citing the English language European counterparts to the cited Hungarian publications. EP 0 402 108 corresponds to HU 210959 (claims priority to the same US patent application as US 5,545,548). EP 0 482 714 corresponds to HU 62334 (claims priority to US 6,083,686). All of these cited corresponding applications contain identical disclosures.

Applicants respectfully request that the currently cited EP patents along with the previously cited US patents be considered for explanation as to the relevance of the two Hungarian publications.

Response to Declaration

Applicants thank the Office for acknowledging that the declaration under 37 CFR 1.132 filed 1/3/2003 overcomes the rejections of claims 1-54 under 35 USC 112, first paragraph.

Double Patenting

Claims 1-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of US Patent No. 6,346,379. The Office asserts that "although the conflicting claims are not identical, they are not patentably distinct".

Applicants file herewith a terminal disclaimer in compliance with 37 CFR § 1.321(c). The present application and the cited patent (US 6,346,379) are commonly owned by Roche Molecular Systems, Inc. Attached herewith is the Assignment and Notice of Recordation of Assignment Document of record in the present application. The present application is a continuation of the application to which the Assignment applies. Accordingly, the Assignment is effective to assign ownership to the present application as well.

Applicants respectfully request reconsideration and withdrawal of the nonstatutory double patenting rejection.

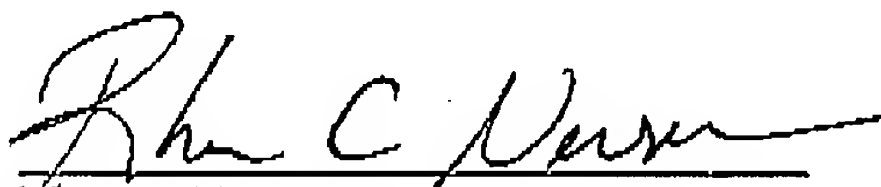
Conclusion

Applicants submit that all of the pending claims are in condition for allowance. Thus, applicants respectfully request issuance of a Notice of Allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 50-0812. Please address all correspondence regarding this matter to Customer No. 22829.

Respectfully submitted,

Date: September 3, 2004


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